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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,988	08/23/2001	Hermann Sicius	Mo-6569/LeA 34,822	1541

34947 7590 05/16/2003

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/935,988

Applicant(s)

SICIUS ET AL

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on MAR. 27 & APR. 21, 2003.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- Of the above claim(s) 9-24 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-8, 25 AND 26 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-26 are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Claims 9-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected inventions. Election was made **without** traverse in Paper No. 8.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 25 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Characklis 4,561,981 in view of Groth et al. 5,371,180. Characklis (esp. Examples I and II, noting also column 2, lines 23-26 as to slow release; and column 3, lines 11-17 as to use in aqueous media such as water) disclose microcapsules containing fouling control chemicals, such as scaling and general deposit control, biological fouling control and corrosion control (column 3, line 25 - column 4, line 30). In Characklis, the scaling and general deposit control agents may be dispersants (e.g. lignosulfonates), surfactants, chelating agents (e.g. EDTA) and various scale control polymers, while the corrosion control additive may be, inter alia, amyl stearate (a fatty acid derivative). While Characklis may not exemplify

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microcapsules containing polysuccinimide and amyl stearate. it would have been obvious to one skilled in the art at the time applicants' invention was made to make microcapsules according to Characklis containing polysuccinimide which Groth et al. (column 4, lines 25-28) teach have many useful functions, i.e. dispersing agent, sequestering agent, scale inhibitor, etc. and the amyl stearate of Characklis (column 4, line 13) as corrosion inhibitor to obtain a slow release conditioning agent for use in aqueous media having several useful functions. The use of known additives for their known functions lacks patentable significance. In this connection, see In re Sussman 554 O.G. 17; 1943 C.D. 518. As to claim 7 herein, it would further have been obvious to one skilled in the art at the time applicants' invention was made to incorporate an oxidizing biocide in the microcapsules of Characklis, modified as above by Groth et al., in view of Characklis (column 3, lines 41-45) to further enhance the corrosion inhibiting effect thereof. See the above-cited Sussman decision and In re Kerkhoven, 205 USPQ 1069. The language in Characklis (column 1, lines 6-39) is suggestive of the use in claim 25 herein.

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-8, 25 and 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claims 1 and thus dependent claims 2-8, 25 and 26 recite a Markush group (as to the "component") which is not considered proper for the reasons that it is indefinite as to scope and incomplete as to its membership in not reciting --and-- between "polysuccinimide," and "mixtures";

b) claim 2 is indefinite and improper and fails to properly point out the invention in stating an amount which is based on the method of application rather than the claimed conditioning agent; and

c) claims 25 and 26 are substantial duplicates of claim 1, and also fail to further limit claim 1, with their slight variations in terminology.

6. The disclosure is objected to because of the following informalities: In the specification page 5, line 21, "FIGURES" should be changed to --DRAWING--.

7. The remaining references listed on the attached Form PTO-1449 (three sheets) and PTO-892 are cumulative to the references applied herein; and/or further show the state of the art.

Appropriate correction is required.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
May 14, 2003

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP ~~100~~ 1700